

REMARKS

In response to the Restriction Requirement set forth in the Office Action of September 10, 2008, Applicants hereby provisionally elect with traverse the invention of Group II, claims 22-25, drawn to a polycarboxylic composition obtainable by the method according to claims 14-21 (Group I).

Applicants traverse this requirement for the following reasons.

First, the requirement is improper as a matter of law. This application is a § 371 national stage application of International Application PCT/FR2003/002702. Accordingly, the Office is required to follow the rules regarding unity of invention in PCT rules 13.1 and 13.2. However, the Office appears to have improperly applied U.S. restriction practice for this application. See, Caterpillar Tractor v. Commissioner of Patents and Trademarks, 650 F. Supp. 218 (E.D. Va 1986); and M.P.E.P. § 1850.

Second, it is respectfully submitted that had unity of invention been applied, unity would have been found to exist and all of the claims would have been examined together in this application. In this regard, Applicants submit that the Office Action fails to satisfy its burden in showing that claims lack of unity under the requirements of PCT Rules 13.1 and 13.2.

Determination of the lack of unity is possible only when the claims of different groups lack a "special technical

feature" relative to one another. In the present case, claim 14 is an independent claim that is generic to the compositions of dependent claims 22-25 and 30-32. In this regard, the polycarboxylic composition of Group II is obtainable by the method according to claims 14-21 of Group I. Also, the compositions of claims 22-25 must be present in the compositions of claims 27-29 (which depend on claims 22-25). Therefore, all of these pending claims by definition share the same special technical feature of claim 14. For this reason, the claims have unity of invention.

Third, the Examiner's attention in this regard is directed to PCT Rule 13.2 in Part 1b of the Annex B of the administrative instructions under the PCT, which specify that "special technical features" is defined as meaning those features that define the contribution which each of the inventions, considered as a whole, makes over the prior art. In other words, PCT Rule 13.2 is art-based and requires the citation of a publication showing the "special technical feature". Therefore, absent any showing that the "special technical feature" shared by all the pending claims is present in the present prior art reference, no determination of lack of unity can properly be made. As the Office fails to provide such a citation, Applicants believe that the lack of unity requirement is improper as a matter of law.

Fourth, in applying this same legal standard with similar claims, the International Searching Authority did not determine the unity of invention as lacking. Thus, the Patent Office has the benefit of the search report, but fails to explain why a different legal conclusion was reached.

Fifth, it is believed that, even if US Restriction was followed, restriction would have been improper. It is well established that there are two criteria for a proper requirement for restriction: (1) the inventions must be independent (see M.P.E.P. §§ 802.01, 806.06, and 808.01) or distinct as claimed (see M.P.E.P §§ 806.05 to 806.05(j)); and (2) there would be a serious burden on the examiner if restriction is not required (see M.P.E.P §§ 803.02, 808, and 808.02).

For the reasons noted above, the claims of the different groups contain overlapping and related subject matter. Consequently, a search of the invention of Group II would necessarily overlap that of at least Groups I and IV-VI. Thus, it is believed that a search of all the claims in their entire scope will not constitute a serious burden on the Office given their related and overlapping subject matter.

It should further be noted that claims 27-29 depend, either directly or indirectly, on the elected claims 22-25. Thus, if elected claims 22-25 are ultimately allowed, their dependent claims should also be allowed.

For these reasons, Applicants submit that the Office's request for restriction is improper. Thus, kindly search and examine of all the claims in their full scope together in this application as the inventions of Group I and Group II have unity of invention.

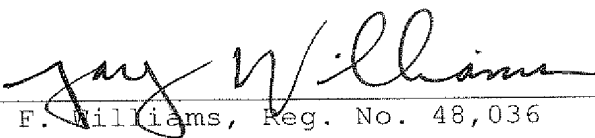
In the event that the Office disagrees with the traversal and maintains the requirement, then kindly consider the possibility of rejoinder of the non-elected invention, upon a determination of allowance of the elected invention, per U.S. rejoinder practice (See M.P.E.P. § 821.04).

Favorable action on the merits is solicited.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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